

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 23, 2006. Applicant previously canceled Claim 8 without prejudice or disclaimer. The Examiner rejects Claims 1-7, 9, and 10. Applicant respectfully traverses these rejections. Applicant respectfully requests reconsideration and favorable action in this case.

Objections to Previous Amendments

The Examiner objects to amendments made by Applicant in a Request for Continued Examination filed August 8, 2006 ("the August 8 Response"). In particular, the Examiner objects, under 35 U.S.C. 132(a) to the addition of the term "electronically" to Claim 1 on the grounds that this amendment allegedly introduces new matter. Nonetheless, as the Application indicates, "workflow manager 110" may be "installed on a local business computer or network." *Application*, p. 5. As a result, the present Application as originally filed clearly indicates that any operations that may be performed by "workflow manager 110" such as "determining the value of the key performance indicator based on the business data" may be performed "electronically." If the Examiner is disputing the suggestion that computers operate electronically, Applicants respectfully request that the Examiner provide evidence to support this assertion. As a result, Applicant respectfully traverses this objection to the amendment of Claim 1 in the August 8 Response.

Section 101 Rejections

The Examiner rejects Claims 1-7 and 9 under 35 U.S.C. § 101 stating that the claimed invention is allegedly directed to non-statutory subject matter. The Examiner bases this rejection on a number of different grounds each of which is addressed and traversed below.

First, the Examiner notes that "the claimed invention must fall within one of the four statutory classes of invention as set forth in § 101 (i.e., (1) a process, (2) machine (apparatus), (3) manufacture (article of manufacture), or (4) composition of matter)." *Office Action*, p. 3. The Examiner further asserts that "[i]n the present case, **method claims 1-7** is [sic] directed to a 'method for reporting a value of a key performance indicator', which is not within one of the classes of invention set forth in § 101." *Office Action*, p. 3, underlining and bold in original. With respect to this argument, Applicant respectfully notes that the M.P.E.P.

specifically states that “[t]he term ‘process’ as defined in 35 U.S.C. 100, means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” M.P.E.P. § 706.03(a), underlining and emphasis added. Thus, a “method” does fall within one of the four statutory classes of invention set forth by 35 U.S.C. § 101. As a result, Applicant respectfully traverses any 35 U.S.C. § 101 rejection based on these grounds.

Similarly, the Examiner rejects Claim 9 by alleging that that Claim 9 “is directed to a ‘system for reporting a value’ comprising mainly software, which is not within one of the classes of invention set forth in § 101....” *Office Action*, p. 4. Applicant respectfully objects to the Examiner’s mischaracterization of Claim 9. The term “software” does not appear anywhere in Claim 9. While Applicant does not intend to, nor is Applicant required to, exclude systems comprising, in part or in whole, software from the scope of Claim 9, Applicant respectfully disputes the Examiner’s contention that Claim 9 only reaches to systems that are “mainly software.”

Furthermore, to the extent that Claim 9 is worded broadly enough to include embodiments of the claimed subject matter that are, in part or in whole, software or software-based, Applicant respectfully notes that software is patentable subject matter. As the M.P.E.P. notes, “[c]omputer programs are often recited as part of a claim.” Thus, software is not excluded from the patentable subject matter identified by 35 U.S.C. § 101. *See, e.g., Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1339, 73 U.S.P.Q.2d 1782, 1793 (Fed. Cir. 2005) (“Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes.”)

Second, despite conceding that the claimed method produces a useful result (e.g., *Office Action*, p. 4), the Examiner insists that the claimed invention must also be “reproducible or repeatable.” *Office Action*, p. 4. To support use of this standard, the Examiner cites to *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000). *In re Swartz* the Court simply determined that because the Examiner had provided several references indicating that cold fusion experiments were irreproducible the Examiner could “reasonably doubt” the asserted utility and operability of the applicant’s claimed subject matter. *Id.* Here the Examiner has provided no references or evidence to challenge the Applicant’s assertions that the claimed subject matter is patentable.

Applicant respectfully reminds the Examiner that the PTO has the initial burden of challenging a presumptively correct assertion of utility in the disclosure. *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436, 1441 (C. A. Fed. 1995). Furthermore, “[o]nly after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility.” *Id.*, underlining and emphasis added; *see also In re Bundy*, 642 F.2d 430, 433, 209 U.S.P.Q. 48, 51 (CCPA 1981). Applicant respectfully notes that the Examiner's conclusions as to whether the claimed subject matter provides reproducible or repeatable results are not evidence and, therefore, are not the proper basis for a rejection under 35 U.S.C. § 101.

Third, the Examiner alleges that “there is no physical transformation of anything to another state or thing....” *Office Action*, p. 4. Applicant respectfully notes that the Federal Circuit has consistently held that physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358-59, 50 U.S.P.Q.2d 1447, 1452 (Fed. Cir. 1999); *see also* M.P.E.P. § 2106.IV.C.2.(2). Furthermore, the method of Claim 1 results in “displaying the determined value of the key performance indicator via a contextual visualization interface,” which clearly represents a physical transformation.

The Examiner continues by noting that “claims 1-7 are thus drawn to the abstract idea of identifying an indicator and determining the value of the indicator and displaying it on a medium, rather than to a practical application of the idea as required by 35 U.S.C. § 101.” *Office Action*, p. 4. Nonetheless, the Federal Circuit has on several occasions held that a process that is utilized to determine a particular value is within the statutory scope of § 101 as the value itself is a useful, non-abstract result. For example, in *AT&T v. Excel*, 172 F.3d at 1358, 50 U.S.P.Q.2d at 1452 (Fed. Cir. 1999), the Court held that a method for determining a primary interexchange carrier (“PIC”) indicator was patentable. The Court held that the PIC indicator represents information about the call recipient's PIC and, thus, was a “useful, non-abstract result.” 172 F.3d at 1358, 50 U.S.P.Q.2d at 1452. *See also, State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1374-75, 47 U.S.P.Q.2d 1596, 1602 (Fed. Cir. 1998); *Arrhythmia Research Technology Inc. v. Corazonix Corp.*, 958 F.2d 1053,

22 U.S.P.Q.2d 1033 (Fed. Cir. 1992); *Arrhythmia Research Technology Inc. v. Corazonix Corp.*, 958 F.2d 1053, 22 U.S.P.Q.2d 1033 (Fed. Cir. 1992). As a result, Claims 1-7 claim a useful and tangible result and are patentable under 35 U.S.C. § 101.

Thus, Applicant respectfully traverses the rejection of Claims 1-7 and 9 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Additionally, Applicant respectfully notes that “[i]f the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, Office personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. § 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim.” M.P.E.P. § 2106.IV.B. **As a result, Applicant respectfully requests that, if the Examiner intends to maintain the 35 U.S.C. § 101 rejection with respect to any claims of this Application, the Examiner identify features disclosed in the written description that would render the claimed subject matter statutory, as required by the M.P.E.P.**

Section 112 Rejections

The Examiner also rejects Claims 1-7, 9, and 10 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. Applicant respectfully traverses this rejection. Applicant respectfully notes that this is the first time the Examiner has raised this enablement rejection with respect to any of the claims of the Application. Applicant respectfully reminds the Examiner that “if an enablement rejection is appropriate, the first Office Action on the merits should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal.” M.P.E.P. § 2164.04. Thus, Applicant respectfully requests the Examiner to reconsider this rejection, particularly in light of the comments below.

As part of this rejection, the Examiner asserts that “there is no citation of how to carry out step (d) or any example of how the value can be determined.” *Office Action*, p. 5. Applicant respectfully notes that this is not a proper basis for rejecting claims under 35 U.S.C. § 112. Applicant reminds the Examiner that “[l]ack of working examples or lack of evidence that the claimed invention works as described should never be the sole reason for

rejecting the claimed invention on the grounds of lack of enablement.” M.P.E.P. § 2164.02.

Furthermore, Applicant again notes that a non-limiting example is provided on pages 8-9 of the Application. In this example, the “Total Profits [Before Taxes]” represents a “key performance indicator” that is affected by “business events” such as sales orders, manufacturing orders, and purchase orders. The actual effect of each of the relevant business events on the “value” of the “key performance indicator” properly depends on the nature of the business event in question. One skilled in the art is however capable of determining the effect of receiving a sales order on “Total Profits.” Thus, while the scope of Claim 1 is not in any way limited by this specific example, the step of “determining the value of the key performance indicator based on the business data” is enabled by the Application as originally filed.

As a result, Applicant respectfully traverses the rejection of Claims 1-7, 9, and 10 under 35 U.S.C. § 112, paragraph 1. Applicant respectfully reminds the Examiner that the Examiner bears the burden of establishing a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993); M.P.E.P. 2164.04. Furthermore, Applicant respectfully reminds the Examiner that, when issuing a rejection on the basis of enablement, “[t]he examiner should **never** make the determination based on personal opinion.” M.P.E.P. § 2164.05, underlining and bold in original. “The determination should always be based on the weight of evidence.” M.P.E.P. § 2164.05. The Examiner has provided **no evidence** that one skilled in the art would not be enabled to practice the claimed invention by the disclosure of the Application.

The Examiner also rejects Claims 1-7, 9, and 10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant respectfully note that the Examiner fails to explain in any manner why the Applicant’s response to the 35 U.S.C. § 112, paragraph 2, rejections in the August 8 Response were not sufficient. Applicant notes that in the “Response to Arguments” section, the Examiner merely states that “the non-limiting example has been reviewed but these are insufficient to overcome the rejections, as addressed above.” *Office Action*, p. 11, underlining and emphasis added. Nonetheless, no further explanation is provided, above or elsewhere, as to the 35 U.S.C. § 112, paragraph 2, rejection (see, e.g., p. 5). In the Response to Office Action filed October

12, 2005, Applicant traversed this rejection but then also amended Claims 1, 9, and 10 for purposes of advancing prosecution. Applicant respectfully notes that the Examiner fails to provide any explanation why the amendment was allegedly insufficient to overcome the Examiner's rejection under 35 U.S.C. § 112, paragraph 2. As a result, Applicant respectfully traverses rejection of Claims 1-7, 9, and 10 under 35 U.S.C. § 112, paragraph 2. **Applicant respectfully requests that, if the Examiner intends to maintain the rejection of any claims under 35 U.S.C. § 112, paragraph 2, that the Examiner provide an explanation for the basis of such a rejection that addresses Claims 1-7, 9, and 10 in their current form.**

Section 103 Rejections

The Examiner rejects Claims 1-7, and 9-10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,546,378 issued to Cook (“Cook”). Claim 1 recites:

A method for reporting a value of a key performance indicator comprising:

receiving information identifying a key performance indicator to monitor;

identifying at least one business event associated with the selected key performance indicator;

receiving a business event message indicating an occurrence of the business event, the business event message including business data describing the business event;

in response to receiving the business event message, electronically determining the value of the key performance indicator based on the business data; and

displaying the determined value of the key performance indicator via a contextual visualization interface.

Cook fails to disclose, teach, or suggest every element of amended Claim 1 for at least several reasons. First, *Cook* fails to disclose “receiving information identifying a key performance indicator to monitor.” Second, *Cook* fails to disclose “receiving a business event message indicating an occurrence of the business event, the business event message including business data describing the business event.” Third, *Cook* fails to disclose “in response to receiving the business event message, determining the value of the key performance indicator based on the business data.” Thus, for at least these reasons, *Cook* fails to disclose, teach, or suggest every element of amended Claim 1, as discussed in further detail below.

At the outset, Applicant respectfully notes that the Examiner fails to address any of the Applicant’s arguments from the Response to Office Action regarding the 35 U.S.C. § 103 rejection. The Examiner merely repeats the arguments from the previous Office Action and notes that “paragraph no. 9 cited above...discloses the location of teachings of steps (a)-(e) in COOK, especially as cited in example 3, cols. 39-40, and examples 11 and 12, cols. 45-46.” *Office Action*, p. 12. Thus, the Examiner fails to address the substance of Applicant’s arguments. Applicant reminds the Examiner that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” M.P.E.P. § 707.07(f) (emphasis and underlining added). **Applicant respectfully requests that the Examiner address the substance of**

Applicant's argument with respect to this aspect of the rejection as required by M.P.E.P § 707.07(f) and not merely repeat the arguments Applicant has already traversed.

Returning again to *Cook*, first, as noted in the August 8 Response, *Cook* fails to disclose “receiving information identifying a key performance indicator to monitor.” In rejecting Claim 1, the Examiner attempts to equate a stock price prediction disclosed by *Cook* with the claimed “key performance indicator.” *Cook* fails to disclose any information “identifying a [stock price prediction] to monitor.” As a result, *Cook* fails to disclose “identifying a key performance indicator to monitor” as recited by amended Claim 1.

Second, as also noted in the August 8 Response, *Cook* fails to disclose “receiving a business event message indicating an occurrence of the business event, the business event message including business data describing the business event.” In addressing this element, the Examiner equates the “business event message” with some unspecified “data” disclosed by *Cook*. To the extent the Examiner is equating the claimed “business event message” with “market historical data” discussed by *Cook* (e.g., col. 39, line 31), Applicant respectfully notes that *Cook* fails to disclose “receiving [market historical data]” and to disclose that the data “indicat[es] the occurrence of [a] business event and describ[es] the business event.” Thus, *Cook* fails to disclose “receiving a business message indicating the occurrence of the business event and describing the business event.”

The Examiner concedes this fact by noting that “COOK fairly teaches the claimed invention except for some relationship between the occurrence of event and the message (data).” *Office Action*, p. 8. The Examiner attempts to address this deficiency by noting that:

However, on example 12, step 7 on col. 40 (or similar teachings on col. 46, step 8), COOK fairly teaches the determination of the relationship between different types of events (occurrence) or the determination of different maps to predicted different features of IBM stock for different periods into the future using collections of market measures and by analyzing wave packets of different lengths, therefore it would have been obvious to a skilled artisan in the data analysis and management to link business event message indicating the occurrence of the business event to the determination of the value of the prediction if desired, as fairly taught in COOK above.

Office Action, pp. 8.

Notwithstanding the Examiner's description of the cited portion, the cited portion does not discuss any types of “event.” Moreover, the Examiner fails to identify any “business event” the occurrence of which is indicated by the “data” as required by Claim 1.

Thus, even if modified as the Examiner proposes, *Cook* fails to disclose “receiving a business message indicating the occurrence of the business event and describing the business event.”

Third, as also noted in the August 8 Response, *Cook* fails to disclose “in response to receiving the business event message, determining the value of the key performance indicator based on the business data.” In rejecting Claim 1, the Examiner equates “data.” As noted above, the Examiner equates the “business event message” with some unspecified “data” disclosed by *Cook*. To the extent the Examiner is equating the claimed “business event message” with “market historical data” discussed by *Cook* (e.g., col. 39, line 31), Applicant respectfully notes that *Cook* fails to disclose any “determining” performed “*in response to receiving the [market historical data]*” (emphasis added). Consequently, *Cook* fails to disclose “in response to receiving the business event message, determining the value of the key performance indicator based on the business data” as recited by Claim 1.

As a result, *Cook* fails to disclose, teach, or suggest every element of amended Claim 1. Claim 1 is thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of Claim 1 and its dependents.

Although of differing scope from Claim 1, Claims 9 and 10 include elements that, for reasons substantially similar to those discussed with respect to Claim 1, are not disclosed, taught, or suggested by *Cook*. Claims 9 and 10 are thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of Claims 9 and 10.

Furthermore, several of the dependents of Claim 1 include additional elements that are not disclosed by the cited portions of *Cook*. For example, Claim 2 recites:

A method according to claim 1, wherein the business event message represents a reference event.

Cook fails to disclose, teach, or suggest additional elements of Claim 2. For example, *Cook* fails to disclose “[a] business event message” that “represents a reference event.” The Examiner addresses this element by stating merely that:

[C]laims 2-6 (part of 1 above), which deals with well known data event parameters, i.e. different type of event features such as reference, change, threshold event, task completion or failure, etc., these are non-essential to the scope of the claimed invention which is “data analysis and management” and are fairly taught in example 12, col. 46, “...relationship between different types of events”.

Office Action, pp. 8-9.

With respect to the Examiner's assertion that Claim 2 "deals with well known data event parameters," Applicant respectfully disputes this assertion. Moreover, Applicant respectfully notes that, to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142. Applicant respectfully reminds the Examiner that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03. Applicant respectfully notes that merely dismissing a claim limitation "as non-essential" is not sufficient to establish a *prima facie* case of obviousness.

Additionally, with respect to the Examiner's assertion that "[a] business event message" that "represents a reference event" is "fairly taught in example 12, col. 46, '...relationship between different types of events,'" Applicant respectfully notes that to whatever extent *Cook* may disclose the existence of "a relationship between different types of events," *Cook* still does not disclose "[a] business event message" that "represents a reference event." As Applicant noted in the August 8 Response, merely disclosing the existence of "a relationship between different types of events" is not sufficient to disclose that a particular event "represents a reference event" as recited by Claim 2.

Consequently, *Cook* fails to disclose, teach, or suggest at least this additional element of Claim 2 and the Examiner fails to establish a *prima facie* case of obviousness. Claim 2 is thus allowable for at least this additional reason. Additionally, Claims 3-6 include elements that, for reasons substantially similar to those discussed with respect to Claim 2, are not disclosed by *Cook*. Claims 3-6 are thus allowable for at least these additional reasons. Applicant respectfully requests reconsideration and allowance of Claims 2-6.

The Examiner also rejects Claims 1-7, and 9-10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,799,286 issued to Morgan ("*Morgan*"). Again, Claim 1 recites:

A method for reporting a value of a key performance indicator comprising:

receiving information identifying a key performance indicator to monitor;

identifying at least one business event associated with the selected key performance indicator;

receiving a business event message indicating an occurrence of the business event, the business event message including business data describing the business event;

in response to receiving the business event message, electronically determining the value of the key performance indicator based on the business data; and

displaying the determined value of the key performance indicator via a contextual visualization interface.

Morgan fails to disclose, teach, or suggest every element of Claim 1 for at least several reasons. First, *Morgan* fails to disclose “receiving a business event message indicating an occurrence of the business event....” Second, *Morgan* fails to disclose “in response to receiving the business event message, electronically determining the value of the key performance indicator based on the business data.” Third, *Morgan* fails to disclose “displaying the determined value of the key performance indicator via a contextual visualization interface.” As a result, as described further below, *Morgan* fails to disclose every element of Claim 1.

First, *Morgan* fails to disclose “receiving a business event message indicating an occurrence of the business event....” In addressing this element of Claim 1, the Examiner simply references Table A and Table B of *Morgan*. Nonetheless, *Morgan* fails to disclose any “business event message indicating an occurrence of the business event...” or any form of “receiving a business event message....” Thus, *Morgan* fails to disclose “receiving a business event message indicating an occurrence of the business event...” as recited by Claim 1.

Second, *Morgan* fails to disclose “in response to receiving the business event message, electronically determining the value of the key performance indicator based on the business data.” As the Examiner concedes, *Morgan* fails to teach any “relationship between the occurrence of event an the message.” *Office Action*, p. 10. Nonetheless, the Examiner asserts that “it would have been obvious to a skilled artisan in the data analysis and management to link business event message indicating the occurrence of the business event to the determination of the value of the prediction *if desired*....” *Office Action*, p. 10. Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, the Examiner must identify, within the references themselves or the knowledge generally available to one of ordinary skill in the art, a suggestion or motivation to modify the reference as proposed. M.P.E.P. § 2143. Applicant respectfully submits that the Examiner provides no such suggestion or motivation. With respect to the proposed combination, the Examiner states only that “it would have been obvious to a skilled artisan” to modify *Morgan*

“if desired.” Office Action, p. 10. This last statement merely serves to emphasize the fact that the Examiner has not identified any motivation or suggestion within *Morgan* to make the proposed modification. As a result, the proposed modification is improper.

Third, *Morgan* fails to disclose “displaying the determined value of the key performance indicator via a contextual visualization interface.” In addressing this element, the Examiner merely references the “monitor/screen display” illustrated in Figures 1 and 2. Moreover, the Examiner earlier equated the claimed “key performance indicator” with the values in Tables D, I, or J of *Morgan*. Nonetheless, Figures 1 and 2 make no reference to “displaying” the values of Tables D, I, or J on the “monitor/screen display.” As a result, *Morgan* fails to disclose “displaying the determined value of the key performance indicator via a contextual visualization interface” as required by Claim 1.

As a result, *Morgan*, in its original form or as modified by the Examiner, fails to disclose, teach, or suggest every element of Claim 1. Additionally, the proposed modification to *Morgan* is improper. Claim 1 is thus allowable. Applicant respectfully requests reconsideration and allowance of Claim 1 and its dependents.

Although of differing scope from Claim 1, Claims 9 and 10 include elements that, for reasons substantially similar to those discussed with respect to Claim 1, are not disclosed, taught, or suggested by *Morgan*. Claims 9 and 10 are thus allowable for at least these reasons. Applicant respectfully requests reconsideration and allowance of Claims 9 and 10.

Conclusions

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or to credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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